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Attorney Docket No: 24065-004CON

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10-9-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Rothenberg et al.

SERIAL NUMBER: 09/981,606

EXAMINER: Not Yet Assigned

FILING DATE: October 16, 2001

ART UNIT: 1656

FOR: Mutations Associated with Iron Disorders

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TECH CENTER 1600/2900

September 30, 2002
Boston, Massachusetts

Commissioner for Patents
Washington, DC 20231

PRELIMINARY AMENDMENT

Prior to examination of the above-identified patent application, please amend the application as set forth below and consider the following remarks.

In the Claims:

Cancel claims 25-52 and 54-58.

REMARKS

Claims 1-24 and 53 are pending. Claims 25-52 and 54-58 were canceled as being drawn to the non-elected invention. No new matter has been added by this amendment.

CONCLUSION

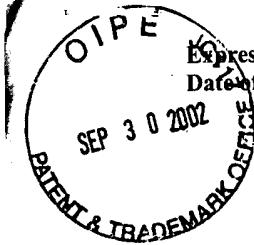
On the basis of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact either of the undersigned at the telephone number provided below.

The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 21486-047.

Respectfully submitted,

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#13 / Electio
Amst
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SERIAL NUMBER: 09/981,606
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RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement mailed on August 28, 2002 (Paper 11), Applicants elect the invention of Group I (claims 1-24), drawn to a method of determining a mutation in exon 2 of an HFE nucleic acid for prosecution in the above-referenced application. This election is made with traverse.

The claims of Group I and Group V should be prosecuted together. The claims of Group I are drawn to a method of determining the presence of a mutation in exon 2 of an HFE nucleic acid, and the claims of group V are drawn to a kit for detecting a mutation in exon 2 of an HFE nucleic acid. The subject matter to be searched in the claims 1-24 of Group I and the single claim (claim 53) of Group V are identical. To illustrate, claim 19 (restriction Group I) and claim 53 (restriction Group V) are repeated below.

19. The method of claim 1, further comprising amplifying said nucleic acid using a first oligonucleotide primer which is 5' to exon 2 and a second oligonucleotide primer is 3' to exon 2.

53. A kit for the detection of the presence of a mutation in exon 2 of an HFE nucleic acid comprising a first oligonucleotide primer which is 5' to exon 2 and a second oligonucleotide primer is 3' to exon 2.

Any art relevant to Group I would be relevant to Group V. Applicants submit that if the restriction is maintained, it is likely that redundant searches, i.e., a search for HFE exon 2

sequences and its flanking sequences, will ultimately be performed in the course of prosecuting the parent and a divisional applications.

Moreover, Applicants submit that claim 53 was misclassified. Group I was classified in class 435/subclass 6 (Class 435: Chemistry: Molecular Biology and Microbiology; subclass 6: Involving Nucleic Acid). The sub-classification notes "Subject matter where the material to be tested or the composition in which the test is conducted contains nucleic acid or the agent used for the measurement or test contains nucleic acid." Claims 1-24 are drawn to "subject matter where the material to be tested" and "the agent used for the measurement or test contains nucleic acid".

Group V was classified in class 435/subclass 287.2 (Class 435: Chemistry: Molecular Biology and Microbiology; subclass 287.2: Measuring or testing for antibody or nucleic acid, or measuring or testing using antibody or nucleic acid). The sub-classification notes "Apparatus with means for the measuring or testing of antibodies or nucleic acids, or with means for using an antibody or nucleic acid to measure or test a sample." However, the claims of Group V do not require an apparatus. Therefore, the classification is inappropriate for this group of claims. Claim 53 is more appropriately classified in the same class as Group I (435/6), because it is drawn to "subject matter where....the agent used for the measurement or test contains a nucleic acid". In fact, claim 19 of Group I and claim 53 of Group V specify the exact same nucleic acid.

Applicants submit that the claims of both Group I and Group V fall into the classification class 435, subclass 6, and that the resources of the Patent Office would be most effectively utilized by examining the claims of Groups I and V together.

Applicants: Rothenber et al.
U.S.S.N.: 09/981,606

No fees are believed to be due. However, the Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311 (Reference No. 24065-004CON).

Respectfully submitted,

IAB
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